

**REMARKS**

This Response, submitted in response to the Office Action dated September 26, 2005, is believed to be fully responsive. Accordingly, favorable reconsideration is respectfully requested.

The Examiner asserts that Applicant's claims are directed to two distinct inventions. Specifically, the Examiner asserts that claims 1-22 and 27-31 ("Invention I") are directed to an apparatus and that claims 13-14 and 23-26 ("Invention II") are directed to "a method of use". The Examiner further asserts that the application contains claims directed to patentably distinct species and requires Applicant to elect a species. The Examiner identifies the following alleged species: Figs. 1-2; Figs. 3-6; Fig. 7; and Fig. 9. Although the Examiner has identified the alleged species with reference to figures, the scope of the claims are not limited to the figures.

Applicant provisionally elects to prosecute Invention I, with traverse, and elects the species of Figs. 1-2, with traverse, on which claims 1-8, 12-16, and 19-31 read. Applicants submits the following arguments in traversal of the restriction and election requirement.

***The restriction requirement should be withdrawn because the requirements of MPEP 806.05(h) are not met.***

MPEP 806.05(h) provides that "[t]he burden is on the examiner to provide an example" of how (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. Once the Examiner provides an example, MPEP § 806.05(h) provides that "[i]f the applicant either proves or provides a convincing argument that the

alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.” The Examiner has not provided any examples to support the restriction requirement. Instead, the Examiner merely asserts, without providing any examples, “the device apparatus could clearly be utilized with numerous other objects and in numerous other environment.”<sup>1</sup> This statement is an erroneous application of the MPEP 806.05(h) requirement that “the product as claimed can be used in a materially different process”, which the Examiner apparently is attempting to rely on. First, that “the device apparatus could clearly be utilized with numerous other objects and in numerous other environments”, as the Examiner asserts, does not speak to the requirement of a “materially different process” because despite the product being allegedly capable of use “with numerous other objects and in numerous other environments”, the *process* may be the same or not materially different when the product is used with other objects and in other environments, which the Examiner does not address. Accordingly, pursuant to MPEP § 806.05(h), Applicant respectfully requests the Examiner to provide a specific example of how the product as claimed can be used in a materially different process or how the process of using as claimed can be practiced with another materially different product including concisely setting forth “the product as claimed”, “the process

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<sup>1</sup> Invention I is not limited to a wastebasket. Accordingly, the Examiner’s statement that “the device apparatus could clearly be utilized with numerous other objects and in numerous other environments, *not just with the wastebasket*” is not relevant.

of using as claimed”, the “materially different process” and the “materially different product.”

If the Examiner cannot meet his burden of providing an example pursuant to MPEP 806.05(h), Applicant respectfully requests the Examiner to withdraw the restriction requirement.

**The election requirement should be withdrawn because there is no serious burden if election is not required.**

Regarding the election requirement, MPEP § 808.01(a) provides:

A requirement for restriction is permissible if there is a patentable difference between the species as claimed *and there would be a serious burden on the examiner if restriction is not required.*

Still further, MPEP § 808.02 provides:

Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, **the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.** Thus the examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof: . . . .

(B) A separate status in the art when they are classifiable together: . . . .

(C) A different field of search: . . . .

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

Contrary to MPEP §§ 808.01(a) and 808.02, the Examiner has failed to explain why there would be a serious burden if election is not required. Accordingly, if the

Examiner continues to insist on the election, Applicant respectfully requests that the Examiner explain why there would be a serious burden if election is not required.

**DUTY TO ANSWER ALL MATERIAL TRAVERSED**

The Examiner is respectfully reminded of the duty to answer all material traversed. See, e.g., MPEP 707.07(f). Specifically,

1. Pursuant to MPEP § 806.05(h), Applicant respectfully requests the Examiner to provide a specific example of how the product as claimed can be used in a materially different process or how the process of using as claimed can be practiced with another materially different product including concisely setting forth “the product as claimed”, “the process of using as claimed”, the “materially different process” and the “materially different product.”

2. Pursuant to MPEP §§ 808.01(a) and 808.02, if the Examiner continues to insist on the election requirement, Applicant respectfully requests that the Examiner explain why there would be a serious burden if election is not required.

**CONCLUSION**

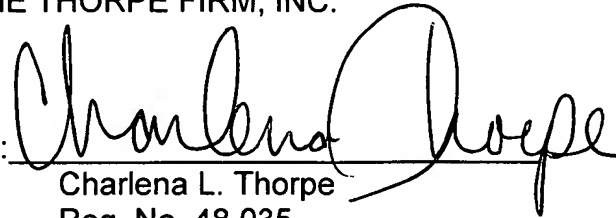
Please grant any extensions of time required to enter this response and charge any additional required fees.

Respectfully submitted,

THE THORPE FIRM, INC.

Dated: October 26, 2005

By:

A handwritten signature in black ink, appearing to read "Charlena L. Thorpe", written over a horizontal line.

Charlena L. Thorpe

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